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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/579,781 12/28/95 AMENDOLA S 07846/002001

11M1/0404

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EXAMINER

MAPLES, J

ART UNIT

PAPER NUMBER

1111

6

DATE MAILED:

04/04/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☐ Responsive to communication(s) filed on _____

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-95 is/are pending in the application.

Of the above, claim(s) 62-95 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 4, 11, 12, 15, 16, 18, 19, 23, 25, 41, 42, 48-50, 52-61 is/are rejected.

☒ Claim(s) 2, 3, 5-10, 13, 14, 17, 20-23, 29, 26-40, 43-47, 51 is/are objected to. BECAUSE OF A REJECTED BASE CLAIM.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

Serial Number: 08/579,781

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Art Unit: 1111

Part III DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

 Group I. Claims 1-61, drawn to an electrochemical storage medium/battery, classified in Class 429, subclass 105.

 Group II. Claims 62-82, drawn to a method of generating a current over time, classified in Class 205, subclass 469.

 Group III. Claims 83-95, drawn to a system of transporting a borohydride anion, classified in Class 429, subclass 72.

2. The inventions are distinct, each from the other because of the following reasons: the method of Group II could be practiced with another and materially different battery than that of Group I such as with a fuel cell not utilizing boron species. Group III is different than either of Groups I or II because the latter two groups do not require a transport step as does the invention of Group III.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Art Unit: 1111

4. During a telephone conversation with John Freeman on March 3, 1997 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-61. Affirmation of this election must be made by applicant in responding to this Office action. Claims 62-95 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4, 11, 12, 15, 16, 18, 19, 23, 25, 42, 48 and 52-61 are rejected under 35 U.S.C. § 102(b) as being anticipated by Struthers.

Reference is made to columns 4-6 of the patent to Struthers along with Figures 6 and 8.

7. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

8. Claims 12 and 41 are rejected under 35 U.S.C. § 103 as being unpatentable over Struthers.

The only claimed subject matter not taught by Strugthers are the tanks for anolyte or catholyte. Such are deemed obvious design expedients to one of ordinary skill in this art so that additional fluid can be added to the cell.

9. Claims 48, 49, 50, 54, 55, 56, 60 and 61 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The expression "such as" in each of claims 48, 49, 50, 60 and 61 is unclear.

The wording of claim 54 is unclear and it is not known what applicant desires to claim therein.

Claim 55 includes language that is indefinite. Words like "form fit" and "function specifications" are unclear. Also, "correct" and "standard" are indefinite.

Claim 56 contains improper Markush terminology.

10. Applicant is requested to amend the "Description of the Drawings" to provide a more complete description of the same.

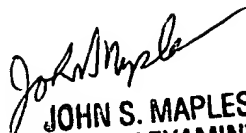
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11. Any inquiry concerning this communication should be directed to John S. Maples at telephone number (703) 308-1795.

JSM/3-28-97


JOHN S. MAPLES
PRIMARY EXAMINER
GROUP 1100